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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/818,175
Filing Date: March 26, 2001
Appellant(s): PERLMAN ET AL.

Matthew C. Phillips
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 June 2005.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3)   Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4)   Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5)   Summary of Invention

The summary of invention contained in the brief is correct.

(6)   Issues

The appellant's statement of the issues in the brief is correct.

(7)   Grouping of Claims

The rejection of claims 1-30 stand or fall together because appellant's brief does not

include a statement that this grouping of claims does not stand or fall together and reasons in

support thereof. See 37 CFR 1.192(c)(7).

(8)   Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   Prior Art of Record

6,564,213 B1   ORTEGA et al.   5-2003

2003/0014753 A1   BEACH et al.   1-2003

(10)   ***Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent

No. 6,564,213 to Ortega et al. (hereinafter Ortega) and U.S. Publication No. 2003/0014753 to

Beach et al. (hereinafter Beach).

Referring to claims 1, 11, and 21, Ortega discloses a method, system, and article of

manufacture that detects a first word entered by a user with a character-entry device (column 3:

lines 12-19) and provides a potential list of second words to the user (Figure 2B). Beach also

discloses a method, system, and article of manufacture that detects a first word entered by a user

with a character-entry device (paragraph [0009]) and provides a potential list of second words to

the user (paragraph [0021] and Figure 4). More particularly, Beach's invention comprises an

entertainment system that detects a first word of a *multimedia program* and subsequently

provides a potential list of second words for the *multimedia program* (paragraph [0018]). As

should be recognized in Figure 4, Beach's invention differs from that of the claimed invention

because the potential list of second words is presented in an alphabetical order and not in an

order based on how frequently a multimedia program whose name includes one of the second

words has been played by the entertainment system. For that feature, the examiner points to

Ortega. While it is clear that Ortega's invention is directed to an online sales system (e.g.,

Amazon.com), the graphical user interface disclosed by Ortega in Figure 2B is quite analogous

to the graphical user interface of Beach disclosed in Figure 4. Both interfaces comprise text entry boxes and lists of potential words that can be used complete desired titles. The list in Ortega's invention, however, is advantageously ordered according to the popularity of the corresponding items. Specifically, Ortega explains in the abstract and in column 2: lines 31-35 that the item titles can be ordered according to how frequently the items are accessed or viewed by users. Therefore, Ortega teaches the one feature missing from Beach, i.e., that the titles displayed in the list of potential second words is based on how frequently the corresponding items are accessed or viewed. This feature, furthermore, is not limited to any particular interface genre. It can be used in any auto-completing graphical user interface where it would be advantageous to present titles according to how likely a user is to select each of the titles. It thus would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the described teachings of Ortega and Beach so as to provide a potential list of second words for a multimedia program wherein the list is based, at least in part, on how frequently a multimedia program whose name includes one of the second words has been played by the entertainment system. It would have been beneficial to do this because the multimedia programs that have been played more frequently are more likely to be selected by the user as supported by Ortega.

Referring to claims 2, 12, and 22, Ortega discloses ordering the potential list of second words based at least in part, on the probability that each word in the potential list of second words will be selected by the user following the first word (column 1: lines 9-54 and column 4: lines 9-14).

Referring to claims 3, 13, and 23, the combination of Ortega and Beach discussed above comprises detecting a second word of the multimedia program selected or entered by the user with a character-entry device and providing a potential list of third words of the multimedia program to the user, the potential list of third words selected based, at least in part, on how frequently a multimedia program whose name includes one of the third words has been played by the entertainment system (see Figure 4 of Beach where potential third words are also displayed).

Referring to claims 4, 14, and 24, the combination of Ortega and Beach comprises ordering the potential list of second words based, at least in part, on how frequently a multimedia program whose name includes one of the second words has been played by the entertainment system as discussed above.

Referring to claims 5, 15, and 25, the second word in the inventions of Ortega and Beach, and ultimately in the combination of the two, may be entered manually by the user via the character-entry device or may be selected by the user from the potential list of second words (see Figure 2B of Ortega and Figure 4 of Beach where the user can either continue entering characters or select one of the suggested words).

Referring to claims 6, 16, and 26, Ortega teaches recording selection of the second word following the first word in a database (see column 4: lines 1-52).

Referring to claims 7, 17, and 27, Ortega discloses linking the second word to the first word in the database (see column 4: lines 1-52, wherein Ortega describes suggesting terms or phrases that are most frequently used – and since phrases consist of multiple words, the first and second words are inherently linked).

Referring to claims 8, 18, and 28, Ortega discloses storing the number of times that the

user has selected the second word following the first word (see column 4: lines 28-33, wherein

Ortega describes monitoring the frequency or number of times a particular query or phrase is

used).

Referring to claims 9, 19, and 29, Ortega calculates a first probability that the second

word will be selected by the user based, at least in part, on said number of times (see Figure 5:

step 86, which shows that a score or probability is assigned to the search terms.

Referring to claims 10, 20, and 30, Ortega discloses calculating a second probability that

the second word will be selected by the user by combining the first probability with a probability

derived from how frequently a phrase (multimedia program) that includes one of the second

words is included in the database, and selecting the potential list of words based, at least in part,

on the second probability (see column 6: lines 27-36).

(11)   Response to Argument

Appellant first asserts that Ortega and Beach alone or in combination fail to teach

suggesting a second word based on "how frequently a multimedia program ... has been played

by the entertainment system" (brief, page 3). More particularly, appellant asserts that the

rejection has wrongly equated this teaching with Ortega's teaching of popularity in an online

merchant system. The examiner respectfully disagrees. As discussed above, Beach discloses an

interface that fundamentally looks and behaves in a manner that is analogous to that of Ortega.

Both interfaces comprise text entry boxes and lists of potential words that can be used complete

desired titles. Beach's invention specifically comprises the claimed entertainment system that

detects a first word of a multimedia program and subsequently provides a potential list of second

words for the multimedia program (paragraph [0018]). Beach's system, a personal video

recorder, further accommodates playing a plurality of multimedia programs. The only feature

separating Beach's invention from that of independent claims 1, 11, and 21 is that the list of

second words is organized according to how frequently each of the corresponding multimedia

programs is actually played. Since Beach teaches playing multimedia programs, a combination

with Beach only requires a teaching of organizing titles in a list according to how frequently they

are accessed and a motivation to combine that teaching with the aforementioned teachings of

Beach. Ortega precisely provides this teaching and motivation. Specifically, in the abstract and

in column 2: lines 31-35, Ortega teaches organizing a list of items for display according to how

frequently the items are "viewed" or "accessed". Ortega further suggests in column 2: lines 41-

48 that this type of organization reduces the number of keystrokes and reflects the browsing

activities and items of interest of one or more users. It should be recognized that Ortega need not

specifically mention the playing of multimedia programs because that teaching is found in

Beach. What's important is that Ortega discloses a graphical user interface in which a list of

titles is suggested to a user according to particular usage patterns, most notably how frequently

each of the items has been accessed or viewed.

Appellant next asserts that Ortega's teachings are vastly different from that of the

claimed invention because Ortega's system is directed to suggesting titles based on the activities

of a population of many users. Appellant submits that Ortega's "popularity" is not the same or

related to how frequently a multimedia program has been played by the entertainment system.

The examiner agrees that Ortega's invention is directed to an online merchant system and that

the popularity of a particular item is determined according to the activities of potentially many

users. However, it must be noted that appellant fails to claim that the instant invention is limited

to one particular user. The invention only requires that the multimedia programs be played on a

single entertainment system. Ortega's invention, similarly, is also implemented within a single

system. While it is true that this system may include numerous client devices as illustrated in

Figure 1, the process of determining how a plurality of titles is arranged is carried out at a single

location. Ortega's system does not necessarily even track the specific client devices that request

certain titles. The system only monitors the "most frequently accessed items over a selected

window of time" (column 2: lines 34-35), no matter where the corresponding requests come

from. This is analogous to the claimed entertainment system in which a plurality of users may

access the system and play a variety of different multimedia programs, but the particular user

accessing the system has no effect on how multimedia titles are ordered. Accordingly, the

examiner submits that Ortega's "popularity" is very similar to how frequently a multimedia

program has been played by an entertainment system. Both inventions comprise a centrally

located system that determines, without regard to a particular user, how frequently a particular

program or item is accessed.

Appellant further asserts that Beach fails to resolve the limitations lacking from Ortega.

As discussed above, the examiner maintains that the combination of Ortega and Beach teaches

each and every limitation of the claimed invention.

Appellant next asserts the combined teachings of Ortega and Beach fail to suggest the

claimed invention. In response, the examiner submits that the combination discloses each and

every limitation of the claimed invention as thoroughly discussed above. Appellant attempts to

deconstruct the combination by bodily incorporating one reference into the other. The test for

obviousness, however, is not whether all of the features of a secondary reference may be bodily

incorporated into the structure of the primary reference; nor is it that the claimed invention must

be expressly suggested in any one or all of the references. Rather, the test is what the combined

teachings of the references would have suggested to those of ordinary skill in the art. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, Beach discloses an

entertainment system comprising all of the limitations except for one. From there, the examiner

refers to Ortega's teaching of the lacking limitation and extracts the relevant teachings as well as

motivation for combining them with those of Beach as discussed in detail above.

Appellant still further asserts that the motivation to combine the teachings was derived

from impermissible hindsight. The examiner respectfully disagrees and submits that Ortega

provides superior motivation. In column 2: lines 41-48, Ortega states that his invention reduces

the number of keystrokes needed to input a particular title and it reflects the browsing activities

and items of interest of one or more users. A reduction in keystrokes alone is a particularly

advantageous feature in any graphical user interface, especially one with a potentially limited

input device. Since the motivation comes from the prior art references themselves, the examiner

maintains that it is not derived from impermissible hindsight.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Brian J Detwiler
Patent Examiner
August 18, 2005

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